

PATENT

P-3611-2-D1-3-C1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of R. Dennis Nesbitt et al.

Serial No.: 09/917,539

Examiner: T. Duong

Filing Date: July 27, 2001

Group Art Unit: 3711

For: LOW SPIN GOLF BALL COMPRISING A METAL, CERAMIC OR
COMPOSITE MANTLE OR INNER LAYER

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 1.193

Appellant hereby presents a Reply to the Examiner's Answer mailed January 30, 2004.

Appellant believes that no fees required under § 1.17 are required, but if an extension of time for filing this brief or any other fee is required, please charge any fees or credit any overpayment to Deposit Account No. 17-0150.

CERTIFICATION UNDER 37 C.F.R. 1.8

I hereby certify that this Reply Brief is being transmitted by facsimile on this date February 9, 2004, to TC3700 at 703-872-9306 addressed to: Attention: Board of Patent Appeals and Interferences, Assistant Commissioner for Patents, Washington, DC 20231.

Michelle Bugbee
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In the present appeal, the issues presented to the Board are: Whether claims 1 to 6 and 8 to 18 are obvious under 35 U.S.C. 103(a) over Sullivan et al. (US 5,820,489) in view of Cavallaro (US 5,688,191), Cavallaro (US 5,810,678) and Harris et al. (US 5,856,388); and whether claims 7 and 19 to 30 are obvious under 35 U.S.C. 103(a) over Sullivan et al. (US 5,820,489) in view of Cavallaro (US 5,688,191), Cavallaro (US 5,810,678) and Harris et al. (US 5,856,388) as applied in claim 1, and further in view of Shama (US 4,848,770), Schenk (US 4,085,937) and Boehm et al. (US 5,683,312).

In the Examiner's Answer, the Examiner discusses the issues and states that "essentially the only real issue present is whether the references can be combined because the facts are that the claims features themselves are individually taught by the prior art" (see Examiner's Answer at p. 2). Appellant respectfully disagrees and submits that as discussed in the Appeal Brief, all of the features are not individually taught in the references.

In the Examiner's Answer, the Examiner states that "Cavallaro '678 teaches explicitly that the addition of fillers or reinforcing materials to the mantle and cover layers of a golf ball will improve the moment of inertia and lower the spin rate" (See Examiner's Answer page 5, emphasis in the original). Appellant respectfully submits that the Examiner has taken the teachings of Cavallaro '678 out of context. Cavallaro '678, at column 14, lines 31 to 44, teaches that moving the filler from the core to the mantle and cover layers increases the moment of inertia and decreases the spin, and the ball preferably has a core, a mantle and a multi-layer cover.

Appellant respectfully submits that the secondary references that the Examiner is relying on teach away from each other and do not teach all of the claim features or Appellant's golf ball. Cavallaro '191 teaches a golf ball with a filler in the core, a mantle comprised of particular thermoplastic materials having a certain flex modulus, and a cover (again, preferably a multi-layer cover), wherein the combination increases the spin, as shown in Tables II and III. This is exactly opposite Cavallaro '678, which is directed to decreasing the spin rate.

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Finally, the Examiner states that “it would be inaccurate to assume the golf balls of Cavallaro generate higher spin rates than the golf balls of Sullivan” (see Examiner’s Answer p. 8). Appellant respectfully submits that Appellant has not stated that the golf balls of Cavallaro generate higher spin rates than the golf balls of Sullivan. Appellant does not disagree that spin rate must be conducted with the same test parameters in order to compare results, as stated by the Examiner. Instead, Appellant has repeatedly used the teachings of the examples to show that the golf balls of Cavallaro ‘191 are directed toward increasing the spin rate of the balls, as shown by the driver and 8-iron test results shown in Tables II and III, where the spin rate clearly increases, while the golf balls of Sullivan are directed toward decreasing the spin rate, as shown by the 9-iron test results in Table 3 (see Appeal Brief at page 9, where Appellant states that “Appellant is merely pointing out that Cavallaro is interested in increasing the spin rate, and his tests show that adding the mantle layer increases the spin, while Sullivan is interested in decreasing the spin rate. The choice of club is irrelevant as the trend or direction (increasing or decreasing) will be the same regardless of which club is used. Applicants are not comparing the absolute spin numbers of the balls of Sullivan and Cavallaro, only the spin rate trend (i.e., whether it increases with the balls of the invention, or whether it decreases), therefore, the fact that different irons are used does not matter”, emphasis added). Appellant is merely pointing out that Cavallaro ‘191 and Sullivan teach away from each other and the data clearly shows this. Cavallaro ‘191 shows that by making the particular soft mantle of the invention, spin rate of a golf ball increases, as compared to a control, while Sullivan shows that by making the soft, thick cover and the particular core, spin rate decreases.

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CONCLUSION

In view of the above, Appellant respectfully submits that claims 1 to 30 are non-obvious and patentable over the cited references. Accordingly, it is respectfully requested that the Examiner's rejection of claims 1 to 30 be reversed.

Respectfully submitted,

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Date: February 9, 2004

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